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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,878	08/29/2003	Patrick Engelking	10022/306	9353
28164 7590 01/12/2009 ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610				
EXAMINER NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/651,878

**Applicant(s)**

ENGELKING ET AL.

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-86 is/are pending in the application.  
4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9, 15-86 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-9 and 15-86, in the reply filed on 9/24/08 is acknowledged. Claims 10-14 have been withdrawn.

### ***Claim Status***

Claims 1-9 and 15-86 are pending. They comprise 5 independent claims sets:

- 1) System<sup>1</sup>: 1-9;
- 2) Product: 15 -19;
- 3) Method<sup>1</sup>: 20-61;
- 4) Method<sup>2</sup>: 62-82; and
- 5) Software: 83-86.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-6, 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Note: that it appears that independent claim 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover

what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

3. Current claims 1-6, 9 comprise a controller, storage device and a user interface which are basically software components. There are no citations of an apparatus or structural elements or devices such as processor or computer or computer server.

4. Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current claims 15-19 comprise a memory embodied on a computer readable memory which appears to be software components. There are no citations of an apparatus or structural elements or devices such as processor or computer or computer server.

5. Claims 83-86 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Current claims 83-86 comprise a user interface which are basically software components. There are no citations of an apparatus or structural elements or devices such as processor or computer or computer server.

#### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 20-82 (method) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter.

Here method claims 20-82 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

8. Claims 1-10, 11-20 and 31-40 are rejected under 35 U.S.C. 101 because in order for a method to be considered a "process" under §101, a claimed process must either:

(1) be tied to another statutory class of invention (such as a particular apparatus)  
or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. (See at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 1-10, the claim language does not include the required (1) tie or (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as “computer-implemented” or “using a computer” features in the preamble and the body of the claims would overcome the rejections.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
13. Claims 1-9, 15-19, 20-46, 47-61, 62-82 and 83-86 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ADLER.

As of 8/29/03, claim 20 is as followed:

20. A method of identifying a business organization transformation opportunity using a software tool operating on a computer, comprising:

- a) receiving at the software tool a plurality of business organization data inputs;
- b) analyzing at least one of the business organization data inputs in accordance with at least one industry threshold; and

c) modeling a business organization transformation opportunity scenario with respect to a particular function of the business organization responsive to the analysis.

Note: for convenience, letters (a)–(c) are added to the beginning of each step.

**ADLER** fairly discloses a method of identifying a business organization transformation opportunity using a software tool operating on a computer, comprising:

a) receiving at the software tool a plurality of business organization data inputs;

{see Fig. 3, element 35, 36, Fig. 6, element 60}

b) analyzing at least one of the business organization data inputs in accordance with at least one industry condition or changing condition (threshold); and

{see Fig. 1, Fig. 3, 36, Fig. 4, element 411, “constraint”, Fig. 9B, paragraph [0014-0015], especially [0026]-[0031] and [0033], and [0099]}

c) modeling a business organization transformation opportunity scenario with respect to a particular function of the business organization responsive to the analysis.

{see Fig. 1A, Fig. 10, par. [0033] and [0099]}

Note that the term “industry threshold” is a relative value and term and is associated with a change. This concept appears to be taught fairly taught in ADLER in [0026]-[0033]. Alternatively, the use of other similar term to indicate a change is

imminent or required such as “threshold” would have been obvious as mere using other similar term.

Moreover, this appears to be a computer-implemented system or “data processing” and limitation such as “threshold”, “client data”, etc, they are considered as non-functional descriptive material (NFDM) on the data of “...”, thus having no patentable weight. The mere insertion of “threshold” or “client data” data over “data” does not “impart functionality when employed as a computer component”, thus having no patentable weight.

See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

As for dep. claims 21-28, 40-41, 43 (part of 20 above) which deal with conventional data input parameters, these are taught in Figs. 3A, elements 306, 304, 301, pars. [0084], [0097-0098].

As for dep. claims 29-39, 42 (part of 20 above) which deal with business modeling scenarios parameters, these are taught in Figs. 1, 1A, 3A, 6, 7, 10, 12, pars [0077], [0137]-[0148] and [0155]-[0160].

As for dep. claims 44-46 (part of 20 above) which deal with business modeling analyzing parameters, these are taught in Figs. 1, 1A, 3, 6, 7, 10, 12, pars [0077], [0137]-[0148] and [0155]-[0160].

As for the method claims 47-61 and 62-82, which basically have the same limitations as in method claims 20-46 above, they are rejected for the same reasons set forth above.

As for independent system claims 1-9, product claims 15-19 and software claims 83-86, they are basically the system, product claims and software claims to carry out the method of claims 20-46 above, and are rejected over the system, product claims and software claims of ADLER to carry out the rejections of method claims 20-46 above.

No claims are allowed.

Art Unit: 3689

14.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689